

REMARKS

Claims 17-27 and 33-44 are pending in this application. All claims stand rejected.

Claims 17, 19, 20, 23, 24, 33-36 and 41-44 stand rejected under 35 USC 102(b) as anticipated by Holman et al., U.S. Patent No. 6,831,769. This rejection is traversed. More specifically, this rejection is traversed on the grounds that Holman does not describe any of (a) a solid electro-optic medium having first and second adhesive layers on opposed sides thereof, as required by present claims 17, 19, 20 and 33-36; or (b) a process using a solid electro-optic medium having first and second adhesive layers on opposed sides thereof, as required by present claims 23, 24 and 41-44.

As a preliminary matter, the undersigned attorney assumes that the rejection was intended to be made under 35 USC 102(e), not 102(b), since Holman was not published until December 14, 2004, long after the present application was filed, and the following arguments assume a 35 USC 102(e) rejection. As a further preliminary matter, applicants note that the statement, in Paragraph 7 of the Office Action, that applicants' arguments with respect to claims 17-27 have been considered but are moot in view of the new grounds of rejection, is not strictly accurate, since the Holman reference applied in the present Office Action, U.S. Patent 6,831,769, is the patent issued on the Holman Patent Publication No. 2003/0025855 applied in the previous Office Action (as may readily be seen from Section (65) on the front page of the patent), and for present purposes the disclosures in the two references are identical. Accordingly, applicants hereby incorporate by references all the arguments made in the Amendment filed on March 14, 2005 distinguishing the present claims from Holman, and would ask that the Examiner now review these arguments on their merits. For brevity, when it is necessary to distinguish herein between the Holman Patent Publication and the issued patent, the former may be referred to as Holman[A] and the latter as Holman[P].

In response to the rejection in Section 3 of the Office Action, applicants note that present claim 17 is directed to an article of manufacture comprising a layer of a

solid electro-optic medium having first and second surfaces *on opposed sides thereof*, a first adhesive layer on the first surface of the layer of solid electro-optic medium, a release sheet disposed on the opposed side of the first adhesive layer from the layer of solid electro-optic medium, and a second adhesive layer on the second surface of the layer of solid electro-optic medium (emphasis added). Thus, this claim requires that the two adhesive layers be present on opposed sides of the electro-optic medium.

The applicants agree with the Examiner's summary of the disclosure in Holman[P] in so far as the Examiner states that Holman[P] discloses in Figure 1 an article of manufacture comprising a layer of a solid electro-optic medium (130) having first and second surfaces on opposed sides thereof, a first adhesive layer (180) on the first surface of the layer of solid electro-optic medium (130), and a release film (190) disposed on the opposed side of the first adhesive layer (180) from the layer of solid electro-optic medium (130). However, applicants do not accept that Holman[P] discloses a second adhesive layer on the second surface of the layer of solid electro-optic medium.

The Examiner states that column 15, lines 1-18 of Holman[P] discloses the second adhesive layer. With respect, this passage makes no reference to a second adhesive layer but simply teaches that the lamination adhesive (as used in the single adhesive layer (180) shown in Figure 1) may be a blend of two or more lamination adhesives. The very term "blend" used shows that the plurality of lamination adhesives are to be employed as a single mixture in the same adhesive layer, not in different adhesive layers cf., for example, Example 1 in columns 16-17 of Holman[P], where a series of blends of two different adhesives are employed in a single adhesive layer. There is nothing in the passage at column 15, lines 1-18 of Holman[P] to suggest the presence of a second adhesive layer.

The preceding paragraph should be sufficient to show that none of claims 17, 19, 20, 23, 24, 33-36 and 41-44 are anticipated by Holman[P]. However, the applicants wish to comment further on the second complete paragraph on Page 3 of the Office Action, in which claim 23 is rejected. This paragraph refers to "laminating the

article to a front substrate (110) via the second adhesive layer (not shown), thereby forming a front subassembly (col. 16, lines 17-20)". With respect, column 16, lines 17-20 does not mention any lamination operation but simply describes the formation of the front plane laminate shown in Figure 1 comprising a substrate, a conductive layer, an electro-optic layer, a lamination adhesive and a release sheet. It is not necessary, and Holman[P] nowhere teaches, a lamination operation to attach the electro-optic layer to the conductive layer; typically, the electro-optic layer is coated directly on to the conductive layer, as taught at column 3, line 60 to column 4, line 3 of Holman[P]. The medium used in Example 6 of Holman[P] is prepared using the same process, as may readily be seen by reference to copending Application Serial No. 10/063,803 (Publication No. 2002/0185378), referred to in this Example.

The 35 USC 103(a) rejection of claims 18, 21, 22, 26, 27 and 37-40 set out in Section 5 of the Office Action is traversed. More specifically, this rejection is traversed for the same reasons as the 35 USC 102 rejection discussed above, namely that Holman[P] does not disclose or render obvious an article of manufacture comprising an electro-optic medium having first and second adhesive layers on opposed sides thereof, nor a process for using such an article of manufacture in a double lamination process as claimed in present claim 23. This rejection is also traversed on the grounds that use of Holman[P] in the present 35 USC 103 rejection is barred by 35 USC 103(c).

As noted above, because Holman[P] was only published December 14, 2004, long after the filing date of the present application, it is available as prior art only under 35 USC 102(e). Under 35 USC 103(c), for applications filed on or after November 29, 1999 (and the present application was filed September 2, 2003), a 35 USC 103 rejection based upon a reference available only under 35 USC 102(e) may be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. This is in fact the case. As may readily be determined from Office records, Holman[P] is assigned to E Ink Corporation, of 733 Concord

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Avenue, Cambridge MA 02138, by an Assignment recorded at Reel 13243, Frames 401-407. The present application is assigned to the same E Ink Corporation by an Assignment recorded at Reel 16213, Frames 462-471. Furthermore, the undersigned attorney, who is the Intellectual Property Counsel of the aforementioned E Ink Corporation, hereby declares, of his own personal knowledge, that the inventors of Holman[P] and the present application were at all relevant times employed by E Ink Corporation under contracts of employment which required them to assign their inventions to the corporation. Accordingly, the use of Holman[P] in a 35 USC 102(e)/103 rejection is barred by 35 USC 103(c), and the rejection is improper.

Reconsideration and allowance of all claims in this application is respectfully requested.

Since the normal period for responding to the Office Action expired September 7, a Petition for a two-month extension of this period is filed herewith.

Respectfully submitted



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